

RECEIVED
CENTRAL FAX CENTER

MAR 30 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Peter Spencer EDWARDS
Serial No.: 10/643,013
Filed: August 18, 2003
Title: PRINTING ON MICROSCOPE SLIDES AND
HISTOLOGY CASSETTES
Group Art Unit: 1762
Examiner: Kirsten Jolley
Attorney Docket No.: TOMK:009A

Certificate of Filing By Facsimile

I hereby certify that this paper is being transmitted via
facsimile to the United States Patent & Trademark Office,
Technology Center I, at telephone number: 703-872-9306

DATE: 03/30/05

By: MARC A. ROSSI

COMMISSIONER FOR PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

Facsimile Transmission

THE FOLLOWING IS BEING FAXED:

Documents	Page(s)
COVER SHEET	1
INFORMATION DISCLOSURE STATEMENT LETTER OF APOGENT AUGUST 6, 2003 LETTER OF APOGENT OCTOBER 3, 2003	8
TOTAL PAGES	9

From:	Marc A. Rossi
Sender's Phone:	(703) 726-6020

CONFIDENTIALITY NOTICE: THIS FAX IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENT(S) NAMED ABOVE. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT(S) OR ANY AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT(S), YOU HAVE RECEIVED THIS FAX IN ERROR, AND THAT YOU ARE NOT AUTHORIZED TO REVIEW, DISSEMINATE, DISTRIBUTE OR COPY THIS FAX. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY THE SENDER IMMEDIATELY. THANK YOU.

COVER SHEET 1

RECEIVED
CENTRAL FAX CENTER

MAR 30 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Peter Spencer EDWARDS

Serial No.: 10/643,013

Filed: August 18, 2003

Title: PRINTING ON MICROSCOPE SLIDES AND
HISTOLOGY CASSETTES

Group Art Unit: 1762

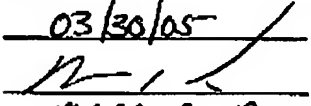
Examiner: Kirsten Jolley

Attorney Docket No.: TOMK:009A

Certificate of Filing By Facsimile

I hereby certify that this paper is being transmitted via
facsimile to the United States Patent & Trademark Office,
Technology Center I, at telephone number: 703-872-9308

DATE: 03/30/05

By: 
MARC A. ROSSI

INFORMATION DISCLOSURE STATEMENT

COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Sir:

In order to comply with applicant's duty of disclosure, the undersigned attorney of record would like to bring the following information to the attention of the examiner:

1. On August 6, 2003, the undersigned attorney of record received a letter from Apogent's counsel (copy enclosed) alleging several instruments had been in use at the Mayo Clinic for more than twelve years, and further alleging the instruments constituted prior art with respect to U.S. Patent Application Publication No. 2001/0039896 A1.

2. U.S. Patent Publication No. 2001/0039896 A1 issued as U.S. Patent No. 6,615,763 on September 9, 2003 based on the parent application from which the present application claims priority.

3. Apogent's letter failed to include any supporting documentation for the allegations contained therein.

SN. 10/643,013

ATTORNEY DOCKET NO. TOMK:009A

4. Although applicant has no affirmative duty to seek out prior art, applicant authorized the undersigned attorney of record to investigate this matter by seeking additional information from Apogent.

5. The undersigned attorney of record requested that Apogent's counsel provide some evidence to support the allegations in the form of: technical publications describing the instruments in detail; operating manuals; work orders for the construction of the instruments; photographs or other materials that would clearly illustrate the actual instruments and their operation.

6. In response, Apogent's counsel forwarded a second letter of October 3, 2003 (copy enclosed) to applicant's attorney of record indicating he had contacted Mayo Clinic, but Mayo Clinic had no interest in cooperating in this matter and had no obligation to insure third party patents were valid. Apogent's counsel did offer the assistance of a Mr. William Hoffman, whom Apogent's counsel alleged was a former Mayo Clinic engineer responsible for the development of the instruments in question, and a picture alleged to be one of the instruments in use by Mayo Clinic. Finally, Apogent's counsel noted that he had no further obligation to put any more effort into gathering information.

7. Noting that applicant has no affirmative duty to seek out prior art, that applicant has no knowledge of the relationship between Apogent and Mr. William Hoffman, and that applicant has no way to verify any statements Mr. William Hoffman might provide given the refusal of Mayo Clinic and Apogent to provide further cooperation, applicant is providing all the information known to the applicant with respect to this matter to the examiner in order to fully comply with applicant's duty of disclosure, such that the examiner may determine whether this information is relevant and/or material to the examination of this application.

8. By the submission of this information, applicant does not concede that the alleged instruments constitute prior art. Applicant notes the original letter of Apogent only provides general comments and does not speak to the specifics of the structure or operation of the alleged instruments. For example, the letter provides no information as to whether the medium is directly sealed or as to the composition of the ink utilized. Further, it is not possible to ascertain whether the alleged use was in fact "public use" given the refusal of Mayo Clinic to

SN. 10/643,013

ATTORNEY DOCKET NO. TOMK:009A

cooperate. Finally, the picture provided by Apogent with the second letter fails to show any detail of the structure or operation of the alleged instruments.

It is requested that the examiner acknowledge receipt and consideration of this disclosure statement with the next correspondence from the Office.

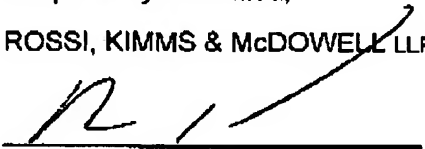
The Commissioner is authorized to charge any fees necessary to enter this paper to Deposit Account 18-2056.

Any questions regarding this issue may be directed to the undersigned attorney of record at the address and telephone number provided below.

Respectfully submitted,

ROSSI, KIMMS & McDOWELL LLP

03/30/05
DATE



MARC A. ROSSI
REG. NO. 31,926

P.O. Box 826
ASHBURN, VA 20146-0826
703-726-6020 (PHONE)
703-726-6024 (FAX)